

REMARKS

The Examiner is thanked for the Office Action dated November 15, 2000. This Response is believed to resolve all issues.

1. A new Reissue Declaration is filed with this Response. The new Declaration has a statement identifying the error, as follows:

“Applicants verily believe that the patent is wholly or partly invalid or ineffectual in that it does not include in the claims the absence of a boiling step.

2. The new Reissue Declaration filed with this Response has a statement negating deceptive intention, as follows:

“Applicants specifically state that “all errors which are being corrected in the reissue application up to the time of filing of the Declaration arose without any deceptive intention on the part of the applicants.”

3. The Examiner is asked to withdraw the ground of rejection of Claims 1-7 related to defects in the Reissue Declaration because the new Reissue Declaration cures such defects. As to any broadening of Claims 1-3, Applicants claim the benefit of the Express Mail filing, with certification, on June 1, 2000, a Thursday. The Reissue Application was date stamped by the USPTO the following Monday, June 5, 2000. The United States Postal Service date of receipt should have been June 1, 2000, or at the latest June 2, 2000, a Friday. The USPTO has been asked to review the mailbag dating and the United States Postal Service dating.

In any event, Claims 1-3 do not “broaden” the patent claims. All previous limitations are retained in Claim 1, with the added limitation of negating the boiling step. There is also a change of wording to use the term “deck,” but this is simply a switch to

the word used to identify the baking shelf in a commercial oven. Such a deck typically is a moving shelf of smooth composition material, carried in a continuous path from the oven door, up around the top and back down past the bottom of the oven and back to the oven door, all the while maintaining a horizontal baking surface.

Prior Art Discussion Not "New Matter."

The Examiner is asked to withdraw the concern about "new matter" related to the "Prior Art" recitation at Page 2, line 1 to Page 3, line 13. A recitation of admitted prior art is by definition not "new matter." This recitation is for the benefit of the Examiner and the public, and as admitted prior art does not form any part of the enablement for the inventive departure from the prior art.

Counsel represents that this subject matter is not "new matter" because it is admitted prior art. Counsel extends this representation negating "new matter" also to the statement added at Page 6, lines 22-25, which avoids the "New Matter" concern in a different manner. The original application, Figure 1, shows the English Muffin bagel with the hole closed to resemble a navel. The original application, in discussion of Figure 1 and Figure 2 (See page 5, lines 21-26 and page 6, lines 9-22) tells how the English Muffin bagel "...central hole 2 tends to approach closure and appears much more a navel. The English Muffin bagel 1 also tends to stretch laterally while baking, and may join its neighbor on the baking pan to form a bite mark 3." This discussion provides the support as required by the Examiner.

In addition, since this is a statement of expected results when following the method, it is easy to review as a double-check that the patented method is being properly followed. Under any circumstances, this is not "New Matter," since it has presence in the original patent application as filed, and further since it is a statement of result from following the method as described. Here again, the Examiner is asked to permit entry of

these statements, as discussion included in the original specification, and also as a statement of results related to the invention as originally filed and claimed.

No Burlap Drying Plank

Counsel apologizes for the misplacement of the subject matter offered for Page 7, lines 2-10 and 12-16. The Examiner's concern is fully appropriate because of the placement outside the "Prior Art" section. In this Response, the same subject matter, slightly altered to omit any discussion of the English muffin bagel, is now offered for placement where it belongs -- in the "Prior Art" section.

The fact that this prior art procedure is simplified, in the case of this English muffin bagel patent application, is of interest. The raw standard bagel is partially-cooked by boiling for a short time just prior to baking. The baker fishes the unbaked, partially-cooked, boiled standard bagels out of the boiling kettle, using a "skimmer," which may also be called a "strainer," which is a sort of wire-net wand. The baker quickly places four to six of the wet, boiling-hot but still unbaked, standard bagels onto a burlap-covered plank (usually a short length of burlap-covered 2 x 4 board used as a drying plank) and places the plank, with bagels on it, onto the deck of the commercial oven. The standard bagels, still on the planks, typically make two revolutions about the oven, and when they again arrive at the oven door, still quite raw but dried, the baker flips the partially baked standard bagels off the planks, turning the bagels upside down directly onto the deck currently presented at the oven door. The standard bagels, now on the oven deck, bake during a number of revolutions, typically ten, about the commercial oven. When next they arrive at the oven door, the standard bagels, now fully baked, are ready to be lifted off the deck, usually with a flat wooden tool called a "peel."

Page 7, lines 13-16 have been deleted. Instead, Applicants have substituted the following statement:

“Because the English muffin bagels are placed directly onto the deck, and because the baking steps do not include any turning of the English muffin bagel, there is no need for any burlap-covered wooden plank, or any flipping operation.” Counsel recognizes that this discussion of things-not-done could possibly raise a concern for new matter, but notes that the inclusion of this negation (things-not-done) is within the teaching of the original patent specification, and is appropriate for easier understanding of the method of the original patent. This method is described positively in a fashion clearly negating the things-not-done, which things-not-done are clearly pointed out in Figure 2 and in the discussion of the standard bagel in the prior art section.

The original patent used the term “...baked on a medium-hot 375 degree F lightly greased griddle until browning occurs.” Nevertheless, since the English muffin bagel is put directly onto the deck --griddle-- without any mention of burlap-covered planks which are used in commercial baking of the standard bagel, used as a transfer from the boiling kettle to the commercial oven, and then used to flip the standard bagels after a partial baking, this should be acceptable.

Applicants have made necessary repositioning of the portion of the reissue text not properly placed in the “Prior Art” section, and have shown how the remainder of the text is supported by the original written description and figures. Counsel, per Examiner’s requirement, has canceled the text subject to Examiner’s concern. Counsel has, however, made the appropriate repositioning, and appropriate corrections, to eliminate concern over new matter.

5. Claims 1-7

The Examiner is asked to reconsider and withdraw any inference in the statement “Claims 1-7... [contain] ... subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.” The

inventors were fully conversant with the invention, had conducted test baking with success, and clearly told others in the original patent application exactly how to practice the invention, including negation of any boiling step.

The inventors clearly stated the limitation of "...omitting any boiling step..." in the original Abstract of the Disclosure, in the chart of Figure 2, and in the original Written Description as follows:

"The major divergence occurs at this point. Standard bagels are boiled and simmered in water..."

Counsel, aware of the rule that the Written Description should include succinct statements equivalent to elements in the claims, is duplicating the statement from the original Abstract "...omitting any boiling step..." Since the statement appeared in the Abstract of the Disclosure, a part of the original Specification, this is not "new matter."

Deck Baking

The limitation of "deck baking said English muffin bagel..." was in the original disclosure, except for the term "deck" which is a common term in commercial baking. The term originally used was "griddle" which is a satisfactory synonym for "deck" in the context of commercial baking, but is not the word most generally used in that context. Either way, griddle or deck, there is a baking shelf.

High-Rise, Light English Muffin Bagel

Counsel apologizes to the Examiner for inclusion of the term "high-rise," which was not in the original specification. This term has been eliminated. Note that the term "high-rise" is not strictly an element of the claim, but rather a statement of result of following the method of the claim, which includes long rising during proofing steps.

Suggestions by Examiner

The Examiner is thanked for suggesting the correction to “kneading” in Claim 1, line 3. Correction had been made.

Claim 1

The Examiner is asked to reconsider the comment with respect to the term “much greater” in Claim 1, with respect to proofing time. This term is clearly supported by the original Written Description and claims, and by the chart of Figure 2, item “P.” It is well-known in baking that rise times are not necessarily exact. Nevertheless, Applicants have deleted the term “much.” With this change, the claim is subject to measurement, as “greater.”

Claim 3

The Examiner is asked to reconsider Claim 3 in the light of amendments. The preamble has been corrected to state “mixed bagel dough ingredients” instead of “bagel ingredients.” “Mixed bagel dough ingredients” are available as the starting point for this claim. The preamble has also been amended to state “said bagel dough ingredients” instead of “said dough.”

Steps a, b, c and d have been amended to state “...step for said bagel dough ingredients...”

The final clause of Claim 3, starting with “resulting,” has been amended to correct grammar. The term “...approaching maximum rising time of the yeast nutrients present.” has been moved to follow the term “yeast nutrients present” which it modifies.

Claim 2 adds a cornmeal coating. Cornmeal is a common coating for breadboards used in bagel baking, and of course is the usual coating for English Muffins. The Examiner is asked to accept Claim 2 as a reasonable dependent claim, under the current relaxed rules of dependent claiming. Note that a cornmeal coating on top is not a part of standard

bagel baking. The novelty persists, and since this is a definitive aspect of the English muffin bagel's appearance, along with the navel and the kiss marks, this claim should be acceptable as a dependent claim.

Claims 5-7 have been canceled in favor of Claim 8. Claim 8 is a product-by-process claim similar to canceled Claim 5, but with changes to follow the Examiner's comments.

Reasons for Reissue

The reasons for reissue are ease of recognition of use of the patented method. There are licensees. There are others who have apparently copied the method, some after derivation from the inventors, and some whose source of information remains unknown. Those who are copying the method typically do so in the back room of a bagelry, with patent owners generally barred from access. The negative limitation of omitting the boiling step is an important part of showing that the method of the patent is being followed, because this is easy to prove. The partially closed navel is also important in that it shows a greater rising than is typical for standard bagels.

8. Section 103

This paragraph quotes Section 103, the operative words are "...if the differences ... are such that the subject matter as a whole would have been obvious ... to a person having ordinary skill in the art."

9. Background for Determining Obviousness

This paragraph lists four case law factors for determining obviousness, including:

- | | |
|-----------------|-----------------|
| 1. Prior art. | 2. Differences. |
| 3. Skill level. | 4. Evidence |

Counsel does not contradict the Examiner's listing of factors.

10. *English Muffins in the Boston Globe*

The Examiner is asked to reconsider this item of prior art. The fact is that the Boston Globe article clearly differentiates bagels from English Muffins, and clearly has no clue as to the English muffin bagel of this patent application.

The Boston Globe article recipe makes it clear that the BAGEL is one thing and the ENGLISH MUFFIN is another. There are separate recipes, under headings as follows:

“Not the yeast of them: BAGELS” and, separately,

“ENGLISH MUFFIN.”

There are separate lists of ingredients, and separate lists of equipment. There are separate combining instructions. There is also a very different set of baking instructions. The Boston Globe article recommends a broiling step and a simmering step for their bagels, as follows:

“... forming dough into a ring shape. Place on greased baking sheet. Cover: let rise ... dough will not double in size.) Broil bagels 5 inches from heat, about 2 minutes on each side. (Surface should not brown.) In large skillet or dutch oven. Reduce heat. Simmer 4 to 5 bagels at a time, about 2 minutes on each side.(Surface should not brown.) Remove from water; drain on absorbent paper.”

“Heat oven to 375. Place bagels on greased baking sheet. ... Bake at 375 oven for 35 to 40 minutes or until golden brown.”

The Boston Globe article, under heading “ENGLISH MUFFINS,” recommends making a batter, using terms: “ ... dissolved yeast into the flour. Beat vigorously ... to make a smooth, loose, thick batter, heavier than the usual pancake batter but not at all like conventional dough ... let rise ... until batter has risen and large bubbles have appeared in the surface.” The Boston Globe article also suggests using “rings or tins” on griddle or frying pan.”

Applicants wish to make it abundantly clear that this patent application does not deal with an English Muffin. It deals with an English muffin bagel. There is no reason for anybody to extrapolate from the fact the Boston Globe article suggests an aggregate long rising for an English Muffin that a bagel baker would forego the traditional boiling step and add a long rising. If English Muffins are desired, the person of ordinary skill in the art would follow an ENGLISH MUFFIN recipe. If bagels are desired, the person of ordinary skill in the art would follow a BAGEL recipe. The Boston Globe article did exactly that. English Muffins are English Muffins, recommended as such by the Boston Globe article with a batter recipe and long rising steps. Bagels are bagels, recommended as such by the Boston Globe article with a dough recipe, short rising steps, and a simmering step. The Boston Globe article recommended standard English Muffins and standard Bagels, and told how to make them quite well. The Boston Globe article also recommended standard pita bread, and told how to make them quite well. The inventors here recommend a new bun, which they call English muffin bagel. It uses a standard bagel dough, but adds a long rising stem and omits the boiling step.

The Examiner is asked to reconsider the commentary under paragraph 10. The fact that the Boston Globe provides a recipe for an English Muffin and also provides a different recipe for a bagel is absolutely contrary to any suggestion that the reader the bagel dough and handle it quite differently from the handling of English Muffin batter or bagel dough in making either English Muffins or bagels.

The sitting of English Muffin batter is simply not equivalent to anything involved in making a bagel. There is no equivalent dough. There is not equivalent rising sequence. There is no suggestion to eliminate the boiling step, which is a definitive step in bagel baking and of course totally disastrous to English Muffin baking.

The Examiner is asked to recant the statement "...the ingredients for the muffin are very similar to the bagel as shown by both recipes for bagel and muffin." Twelve bagels use 2 to 2 1/4 cups bread flour and 1 cup ground oat flour, plus two packages yeast.

Twelve English Muffins use 2 1/2 cups all-purpose flour and 2 tablespoons instant mashed potatoes plus 1 tablespoon yeast. Sixteen pitas use 5 to 6 cups flour and 2 packages yeast. Bagels, in the Boston Globe recipe, have no shortening at all. Pitas, in the Boston Globe recipe, have 1/4 cup oil. English Muffins, in the Boston Globe recipe, have 2 to 3 tablespoons butter. The Boston Globe considered English Muffins, pitas, and bagels sufficiently different to provide full lists of ingredients for their special versions, and to provide full instructions for baking. The ingredients differed substantially. The instructions for baking differed substantially.

Claim 6

The Examiner is asked to withdraw the comments concerning Claim 6. Applicants do not argue to possibility of varying the size of a bun. Nevertheless, a bun is generally a single-serving size. Applicants do, however, contend that the result of following the method of this Reissue patent application does in fact result in discernible characteristics. Of course these characteristics are somewhat relative. There is a difference between a loaf and a bun, even if the ingredients should be the same. There is a difference between a bagel and a croissant, between a bagel and a biscuit; between an English Muffin and a doughnut. There are cake doughnuts and glazed doughnuts and crullers. There are hamburger buns and hot dog buns. All differences are related to ingredients, size, shape, baking techniques and other aspects of baking.

As to the kiss marks, this does indeed make a bagel to be different. A kiss mark is a mark of shame to the standard bagel. The bagel should be round, have a clear round hole, have a smooth tough skin, and should be chewy. The kiss mark will occur in the case of the English muffin bagel because the long rising step allows for lateral growth, and because it is favored by the baker for the English Muffin bagel, and because the English muffin bagel negates the boiling step which defines the standard bagel. The partially-closed navel is typical of the English muffin bagel of this Reissue application, but would

be a fault in a standard bagel. There is a similar bun called a bialy, which has no central hole, but a bialy does not have a partially closed navel.

Conclusion

Applicants have shown how the claims cover the novel method which they have invented, and how the claims differentiate from the prior art. Applicants have demonstrated how the novel method results in a distinguishable bun. Applicants have brought this new bun, which they call the English muffin bagel, to the public. The English muffin bagel has received the approval of the public where it is being offered, as a distinct bun separately offered and separately purchased. Patent licenses have been offered and accepted. There have been instances of copying.

The Examiner is asked to accept these Remarks and to allow the Reissue application with the claims as currently offered.

Respectfully,

Robert W. Brown and Bruce A. Kade

by Carl C. Kling

Carl C. Kling, Attorney

(Reg. 19137)

1. A method of preparing bagel ingredients to form an English muffin bagel,
characterized by

- a) mixing a bagel-dough mix;
- b) kneadng said bagel-dough mix;

c) letting said bagel-dough mix rise in a warm environment to form
first-rise bagel dough;

10

d) shaping said first-rise bagel dough into individual bun portions;

e) letting said bagel-dough individual bun portions rise in a warm
environment to form second-rise bagel dough individual bun portions;

f) proofing said second-rise bagel dough individual bun portions in a
warm environment for a proof time much greater than the sum of rise times in
steps c and e to form English muffin bagel dough individual bun portions; [and]

20 [g) ~~o~~[O]mitting any boiling step and omitting any partial baking step on any
isolating planks on the deck of a commercial oven; and

H) ~~d~~[D]eck [griddle]-baking said English muffin bagel dough individual
bun portions to form completed English muffin bagels.

2. A method of preparing bagel ingredients to form English muffin bagels, according to Claim 1

further characterized in that:

step [(f) is followed] (H) is preceded by an intermediate step (f.1) of water-misting and coating top and bottom surfaces of said English muffin bagel individual bun portions with a thin layer of cornmeal.

3. A method of preparing bagel ingredients to form English muffin bagels,

characterized by:

- a) a first rising step;
- b) a second rising step;
- c) a very long proofing step in which maximum rising for the yeast nutrients present is approached; and
- d) a baking step__:_[.]

10 any boiling step is omitted and any partial baking step on any isolating planks on the deck of a commercial oven; is omitted, resulting in a high-rise, light, English muffin bagel.

4. A method of preparing bagel ingredients to form English muffin bagels according to Claim 3 , in which said very long proofing step takes 3 hours.

8. An English muffin bagel prepared from mixed bagel dough ingredients by the process

characterized by:

a) a first rising step prior to bagel forming and placement of formed bagels on a board;

b) a second rising step;

c) a very long proofing step for bagels, still on the board, in which maximum rising for the yeast nutrients present is approached, resulting generally in the bagels expanding beyond standard bagel rising, partially closing the navel, and touching adjacent bagels to form kiss marks; and

d) a baking step;

omitting any boiling step and any partial baking step on any isolating plank, resulting in a light English muffin bagel of texture intermediate the standard bagel and the standard English muffin.